

Noli IP Newsletter

NOLI IP Solutions, PC

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Genericness is the Enemy: How Great Success Could Kill your Mark

By Judit Marai and Mariana Noli

When you start a business, you can only aspire to its success as the result for all your hard work. A well-known mark is a strong mark. You think that no one would question whether your mark is entitled to registration, since it meets the basic requirements

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of trademark protection, mainly, it identifies you as manufacturer or service provider distinguishing your business’ goods and services from the ones provided by other companies. *“Awesome! That was the point of branding”* you would say. But be careful: Great Success could backfire.

This is the so-called “Genericness” when we talk about trademarks. A generic term cannot be registered. When a word becomes generic by wide usage (“Genericide”), it stops functioning as a source identifier and will no longer be eligible for registration. Customers will recognize the type of goods or services you provide by that term

Warm Welcome Erica Verdin to our Noli IP Family

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We, at **Noli IP Solutions, PC**, are very pleased to welcome Ms. Erica Christina Verdin to our small family.

Starting this month, Erica will be working in accounting department, mainly, handling the financial aspects of the business from day-to-day transactions to addressing any questions our clients may have about our billing and fees. Please do not hesitate to contact Erica if you have any questions about our billing rates, fee schedules for US and international filings, as well as our retainer options for general business consulting services offered to clients. She can be reached at 619-400-4842 or via e-mail at erica@noli-ipsolutions.com.

instead of certain of those goods or services coming from a particular source, your business.

The latest and hottest example is the battle relating to the GOOGLE trademark. You may recall back in 2012, an individual named David Elliot requested the cancellation of the trademark GOOGLE because allegedly the word had become generic, identifying search engines in general. Honestly, who has not heard the expression: “*I googled this and that on the internet*”? Google defended its trademark registration by proving that even though people recognize the meaning

of “Google” as using any kind of search engine, the majority (90%+) of consumers recognized the “trademark designating the Google search engine.” The line where the trademark protection ends, and Genericism starts is hard to visualize at times. In the Google suit proving that we use googling on the internet, but we do not use googling on Yahoo was enough to keep the registration enforceable. As Google, other brands (like Kleenex, Band-Aid, Xerox, Photoshop, Skype, etc.) are still holding up despite the attacks.

So far, they have succeeded to keep trademark protection.

One may say that the best thing that could happen is that your brand becomes so successful and widely known that people start incorporating it in their ordinary vocabulary, but you never want to control over your trademark and its usage. Remember it was you who built that brand spending a lot of time, energy and money on it. We highly encourage you to monitor the usage of your trademark/s.

For more information on this particular topic and other related issues, please feel free to contact us via email at mail@noli-ipsolutions.com.

The Grace Period is Over. Say Goodbye to your Trademark Rights

By Monica Hernandez and Mariana Noli

A few weeks ago, one of our international clients reached out to us inquiring about the enforcement against infringers of their registered trademark. During our due diligence, we discovered that while they obtained a registration of their mark, they had not been made aware by previous counsel that for the registration to remain enforceable, certain submissions and fees must be paid to the USPTO within specific time periods.

In order to maintain your US federal trademark registration, Registrant must take the following actions: (1) file a Declaration of Use and/or Excusable Non-Use of the Mark under Section 8 between the 5th and 6th year from the registration date; and (2) file a Combined Declaration of Use and/or Excusable Non-Use together with an Application for Renewal under Section 8 and 9 every 10 years from the registration date.

So what happens when you do not meet these deadlines? Do you lose all your rights to your US federal trademark registration? Is there any hope/actions left? Yes, there is the Grace Period. The Grace Period is a six month extension of time granted by the USPTO for you to comply with the required actions upon the payment of an additional fee. This is the last opportunity for the Registrant to keep its rights.

After that, there is no hope.

So why is so important to keep these deadlines in mind? What happens after the Grace Period expires? The USPTO will cancel any registration on either the Principal Register or the Supplemental Register if a timely §8 Declaration is not filed by the current owner of the registration during the prescribed time periods. The USPTO has no authority to waive or extend the deadline

for filing a proper §8 Declaration. Registrations cancelled due to the failure to file a §8 Declaration cannot be reinstated or "revived." A new application to pursue registration of the mark again must be filed. The Director has no authority to waive a statutory requirement, such as the deadline for filing a §8 affidavit or renewal application. **In re Holland American Wafer Co., 737**

F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

Therefore, if the registrant did not timely file a §8 affidavit or renewal application, a petition to extend or waive the statutory deadline will be denied, regardless of the reason for the delay. For more information on the maintenance of your registrations, please do not hesitate to contact us at mail@noli-ipsolutions.com.

“Celebrando Latinas 2015” Convention at the Bayfront Hilton Hotel, San Diego, CA

Ms. Mariana Noli and Ms. Monica Hernandez had the pleasure to represent Noli IP Solutions, PC at the “Celebrando Latinas” Conference last Saturday, August 29, 2015. The country’s largest Latina conference in Spanish hosted business professionals and local celebrities for a day of empowerment, celebration and education. This conference provided a unique educational experience relating to the most relevant topics and issues Latinas in the US face today. Through motivational keynote speakers, workshops and interactive sessions, we connected with our community. For more information about the “Celebrando Latinas” Conference, please visit: <http://www.celebrandolatinas.com/>

